

Remarks

Claims 1-13, 16, and 21-24 are pending.

Claims 14, 15, and 17-20 are canceled.

Claims 16 and 21 are withdrawn.

Claims 3, 5-9, 11 - 13, 22, and 24 are currently amended.

Applicant respectfully asserts that the claims are in condition for allowance and such allowance is, respectfully requested.

Applicant has amended claim 16 to overcome the Examiner's objection. Similarly, Applicant has amended claims 22 and 24 consistent with the comments in the Examiner's objection.

With regard to the Examiner's rejection of claims 1-13 under 35 U.S.C. §102(b) or, in the alternative under 35 U.S.C. §103(a), Applicant respectfully asserts claims 1-13 as amended herein and in combination with the following remarks places these claims in condition for allowance. As such, Applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) based on the references cited by the Examiner.

With regard to the cited reference WO 91/15435 A (Alborg, Portland, A/S - whole document) ("hereinafter WO '435"), this reference does not refer to tin compounds. While the WO '435 reference discloses the addition of Mn(II) compounds for the reduction of Cr(VI) in cement, it does not disclose nor refer to tin compounds as set forth in the claims.

With regard to the reference EP 0960865 A (Zell Wildshausen Chemwerke-Born, et al. - whole documents) (hereinafter "EP '865"). This reference does not disclose a suspension of tin hydroxide. While the EP '865 reference discloses an additive for the reduction of Cr(VI) ions and cement comprising tin (II) ions in association with lignosulfonic acid (LSS), the reference does not disclose a suspension of tin hydroxide as set forth in the claims.

With reference to the Japanese abstract, JP 08 100343 abstract ("hereinafter "JP '343") this abstract does not disclose a suspension of tin hydroxide. While the JP '343 reference discloses an additive for the reduction of Cr(VI) in cement obtained by mixing ferrous, stannous, vanadous, and cuprous salts with other additives for concrete which are then mixed with water, it fails to disclose a suspension of tin hydroxide.

Turning now to the reference WO 00/61517 A (Holderbank – whole document) (hereinafter “WO ‘517”), this reference does not mention compounds or complexes of tin. While the WO ‘517 reference discloses a process for reducing the Cr(VI) content of binders by addition of organometallic compounds or complexes, this reference does not mention such compounds or complexes of tin.

Additionally, none of the cited references suggest the other elements specified in the amended claims such as pH range, hydroxide content, and the presence of a water soluble stabilization agent.

With regard to the rejection under 35 U.S.C. §102, it is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Manufacture Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a particular prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH*, see *American Hoist and Derrick Company*, 221 USPQ 481, 485 (Fed. Cir. 1984). Furthermore, in a rejection under 35 U.S.C. §102(b) there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001,1010 (Fed. Cir. 1991).

With regard to the Examiner’s rejection 35 U.S.C. §102(b), Applicant respectfully asserts that each and every element recited in the amended claims cannot be found in any particular prior art reference nor are such elements arranged as in the amended claims. In other words, none of the prior art references provide an identity of invention with regard to the amended claims. Clearly, there is a difference between what is claimed and which is disclosed in the applied references.

In summary, the WO ‘435 reference does not refer to tin compounds. The EP ‘865 reference does not disclose a suspension of tin hydroxide. Similarly, the JP ‘343 reference does not disclose a suspension of tin hydroxide. Finally, the WO ‘517 reference does not mention compounds or complexes of tin.

As such, there is distinction between each and every one of the references cited by the Examiner creating a difference between what is claimed and which is disclosed in the references.

With the foregoing in mind, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C §102(b). Applicant respectfully requests the Examiner to allow the claims over the cited references.

Further, with regard to the rejections under 35 U.S.C. §103(a), it is respectfully submitted that Applicant's claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to Section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon by the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the Applicants' disclosure.

Based on the discussion provided above identifying distinctions between the cited references and the amended claims, Applicant respectfully asserts that the amended claims overcome and are allowable over the Examiner's rejections under 35 U.S.C. §103. First, as noted above, there are specific distinctions between each of the four cited references and the amended claims. Further, there is no suggestion or motivation in the prior art references to modify the reference to achieve the teachings of the amended claims.

Each of the four references does not provide any information which would provide a reasonable expectation of success in obtaining the claimed invention. Each one of the references fails to disclose, refer, or otherwise mention tin compounds (WO '435), a suspension of tin hydroxide (EP '865 and JP '343), and compounds or complexes of tin (WO'517). The absence of these elements from the cited references shows that there can be no reasonable expectation of success in obtaining the claimed invention based on the references relied upon by the Examiner. Lastly, as clearly noted above, none of the prior art references teach or suggest all of the claimed limitations. The absence of elements or limitations clearly shows that there is no teaching or suggestion.

Additionally, none of the cited references suggest the other features specified in the amended claims such as the relevant pH range, hydroxide content, and the presence of a water soluble stabilization agent.

With the foregoing in mind, Applicant respectfully asserts that there is no reasonable suggestion or motivation in the prior art to neither modify the references nor combine the teachings to include the invention as set forth in the amended claims. There is no expectation of success in obtaining the claimed invention since specific limitations are completely absent from the prior art references. Finally, the prior art references do not either individually or in combination teach all the claim limitations.

Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. §103. Applicant respectfully asserts that claims 1-13 are allowable as amended and requests early allowance of these claims.

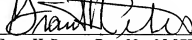
If there is any issue remaining to be resolved, the Examiner is invited to contact the undersigned attorney by telephone so that resolution can be promptly effected.

Attorney Docket No. 38624-102552
Application No. 10/595,086

It is believed that fees are not required for this Response, however it is requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and any other fees or shortages in other fees, being charged, or any overpayment in such fees being credited, to the Deposit Account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 acknowledging attorney docket no. (38624-102552).

Respectfully submitted,

BARNES & THORNBURG LLP



Date: February 19, 2009

Grant H. Peters, Reg. No. 35,977
One of the Attorneys for Applicant(s)
P.O. Box 2786
Chicago, Illinois 60690-2786
Phone: 312-357-1313
Facsimile: 312-759-5646
Customer No.: 23644